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DIRECTOR'S OFFICE
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In re Application of:)
GILBERT, BARRIE)
Application No. 09/545,691)
Filed: April 7, 2000) **DECISION ON PETITION**
For: RF MIXER WITH INDUCTIVE) **UNDER 37 CFR §1.181**
DEGENERATION)

This is a decision on the petition filed November 26, 2002, requesting reopening prosecution following the Examiner's Answer of September 26, 2002.

The petition is **Granted.**

Petitioner requests that prosecution be reopened due to an impermissible new ground of rejection set forth in the Examiner's Answer mailed September 26, 2002 (paper #16).

The Examiner issued a Final Office action on December 20, 2001 (Paper No. 8). In the action the examiner rejected claim 15 under 35 U.S.C. § 103 over Voinigescu et al. (5,789,799) in view of Mitzlaff (5,307,512). At page 5, lines 3-10, the examiner indicated that their position regarding Voinigescu et al. ('799) was that Voinigescu et al. discloses "..first and second input terminals", read on items RF and LO of Figure 9, "first [sic] and second output terminals" (read on item IF of Figure 9) " first input stage coupled to the first and second output terminals" (read on item Q1 of Figure 9), and " ..a second input stage coupled to the first and second output terminals and arranged to drive the first and second output terminals responsive to a second input signals received at the second input terminal" (read on item Q3 of Figure 9).

In response to the Final Office action, applicant filed an After Final amendment on February 27, 2002 (Paper No. 11). The Office mailed an Advisory Action on March 26, 2002 (Paper No. 13) and applicant filed a Notice of Appeal on May 31, 2002 (Paper No. 14), and a timely Appeal brief on August 09, 2002 (Paper No. 15). In the After Final amendment, applicant presented arguments with respect to the Office's position on claim 15 stating that a class AB stage is understood to have two active devices that deliver power for alternate half cycles and that the Office's position with respect to items Q1 and Q3 of Figure 9 could not meet this requirement.

The Advisory Action failed to respond to this argument or to point out the "typographical error in the Final Office action. In the Appeal Brief at pages 3, appellant again presents arguments in regard to claim 15 and "In the configuration shown in Fig. 9 of Voinigescu, the output of transistor Q3 is provided at its collector (the diagonal line without an arrow head)...If transistor Q3 is interpreted as the first input stage in claim 15, then it is only arranged to drive one of the outputs IF-, not both outputs as recited in claim 15".

In response to the arguments presented in the Appeal Brief, the examiner mailed an Examiner's Answer on September 26, 2002 (Paper No. 16). In section 10 of the Examiner's Answer, re-presents the grounds of rejection as set forth in the Final Office action, but now with the addition of transistors Q2 and Q6. In subsections 1 of section 11 of the Examiner's Answer at page 5, the examiner clarifies the rejection by stating that "Note that while the previous action contained a typographical error in that only one side of the mixer arrangement was mentioned, clearly the arrangement requires Q3 and Q6 to be coupled to the LO, and Q1 and Q2 to be coupled to the RF input."

Petitioner alleges that the examiner has changed the grounds of rejection by the inclusion of the additional components of the mixer, i.e., Q2 and Q6 thus the Examiner is advancing a new interpretation of the prior art that is significantly different than the interpretation set forth in the Final Office Action.

MPEP § 1208.1 states:

> "37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. At the time of preparing the answer to an appeal brief, however, the examiner may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d). There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection."

As can be seen above, the instant record is clear that the examiner has clearly set forth the statutory grounds of rejection, but that the thrust of the rejection has changed from the Final Rejection, Advisory Action, through the Examiner's Answer. The examiner's position has been modified to include new structural elements alleged to have been left out as a typographical error. Such a structural modification to support the examiner's position is not permitted by 37 CFR §1.193(a)(2) and MPEP § 1208.1 and is considered to be a new grounds of rejection. Hence, appellant has not been given a fair an reasonable opportunity to respond to the rejection and appellant has provided an adequate showing that the thrust of the examiner's position has changed between the Final Rejection and the Examiner's Answer.

Therefore, the petition to invoke the supervisory authority of the Commissioner under 37 CFR §1.181 and reopen prosecution is **GRANTED**.

The application will be forwarded to Technology Center 2600's Tech Support for entry of the After Final Amendment and then forwarded to the Examiner for action.

Allen MacDonald

Allen MacDonald, Director
Technology Center 2600
Communications